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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,115	07/30/2003	Neil John Graham	51,179	5929
7590 12/29/2005			EXAMINER	
Neil John Graham 6017 Lido Lane			EL ARINI, ZEINAB	
Long Beach, C			ART UNIT	PAPER NUMBER
,			1746	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/629,115	GRAHAM, NEIL JOHN				
Office Action Summary	Examiner	Art Unit				
	Zeinab E. EL-Arini	1746				
The MAILING DATE of this communication app Period for Reply  A SHORTENED STATUTORY REPLODED FOR REPLY		·				
<ul> <li>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.</li> <li>Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>						
Status						
1) Responsive to communication(s) filed on 10/6/	Responsive to communication(s) filed on 10/6/05,9/22/05.					
)⊠ This action is <b>FINAL</b> . 2b)□ This action is non-final.						
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4)⊠ Claim(s) <u>1-21</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6)⊠ Claim(s) <u>1-21</u> is/are rejected.		·				
· · · · · · · · · · · · · · · · · · ·	7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election requirement.					
Application Papers						
9)☐ The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
1. Certified copies of the priority documents have been received.						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s)						
1) Notice of References Cited (PTO-892)  4) Interview Summary (PTO-413)						
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  Notice of Informal Patent Application (PTO-152)						
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	6) Other:	atent Application (PTO-152)				
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#### **DETAILED ACTION**

The amendment filed 10/6/05 and the remarks filed 9/22/05 have been acknowledged and entered.

### Claim Rejections - 35 USC § 112

- 1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 2. The rejection under 35 U.S.C. 112, second paragraph, stated in paper No. 081705 has been withdrawn in view of applicant's amendment.
- 3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
  - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for "in intimate contact with an eye" as is now claimed in claims 1, 7, 12, and 17.

## Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoup (4,123,098).

Shoup teaches a contact lens placement instrument. The reference also teaches in placing the soft contact lens on a person's eye, the insertion device 10 is also held with one hand around the flexible bulb 12 and the bulb 12 is squeezed slightly to provide suction to grip the back surface portion of the soft contact lens which is usually picked off a person's hand after rinsing with a saline solution. The reference discloses the placement instrument as claimed. The reference also teaches releasing the contact lens with a puff of air as claimed. See figs. 1-4, col. 2, line 38-col. 4, line 26, and the claims.

The reference does not teach the dipping steps as claimed.

It would have been obvious for one skilled in the art to use the step of dipping the contact lens in the cleaning solution before placing said contact lens in the eye because it is well known in the art. See col. 4, lines17-19. It would have been obvious for one skilled in the art to use the step of dipping the contact lens in cleaning solution repeatedly to enhance the cleaning and because it is well known in the art. The contact lens as claimed is well known in the art.

This rejection stated in paper No. 081705 is maintained.

### Response to Arguments

7. Applicant's arguments filed 9/22/05 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., (in the present invention in Figs. 1, 4, 5, and 6, the tip of the contact lens tool is considerably smaller in diameter than the contact lens diameter which is critically necessary for rinsing the contact lens while it is being held by the contact lens tool. As disclosed in Fig. 5 the tip of the contact lens tool is not submerged in the solution when the contact lens is dipped in the solution), the present invention has a cup of only 4-6 mm in diameter to allow for vision around the cup and to prevent any suction ability for safety reasons) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is not clear if the applicant uses the same instrument (thumb and finger) for gripping and placing the contact lens (claims 1, 7, 12, and 17).

#### Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeinab E. EL-Arini whose telephone number is (571) 272-1301. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

> Zeinal Elanini Zeinab E. EL-Arini Primary Examiner

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ZEE 08/17/05